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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,917	08/18/2003	Heribert Lorenz	101216-34	3649

27387 7590 01/25/2005

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/642,917	Applicant(s) LORENZ ET AL.	
	Examiner Eisa B Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/4/2005 has been entered.

Claim Rejections - 35 USC § 103

2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Audousset et al. (US 5,578,087) in view of Rose et al. (US 4,003,699).

Audousset et al. (US' 087) teaches a hair dyeing composition comprising developers (oxidation bases) such as 3-chloro-4-aminophenol (see col. 3, line 55) and coupler compounds of such as 1-(2-hydroxy-ethyloxy)-2,4-diaminobenzene (see col. 5, lines 1-2).

Although Audousset et al. (US' 078) teaches a hair dyeing composition comprising the oxidation base 3-chloro-p-aminophenol as claimed in claim 1 a) and the coupler 1-(2-hydroxy-ethyloxy)-2,4-diaminobenzene as claimed in claim 1 c), the reference does not teach the dyeing compounds as claimed in claim 1 b).

However, the reference teaches that the dyeing composition can also contain other couplers customarily used in dyeing composition for keratinous fibers (see col. 5, lines 28-29).

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Rose et al. (US' 699) in analogous art of hair dyeing formulation, teaches a composition comprising 3-morpholinophenol (see col. 9, line 68).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the dyeing composition of Audousset et al. (US' 078) by incorporating the 3-morpholinophenol as taught by Rose et al. (US' 699) to make such a composition with the reasonable expectation of success. Such a modification would be obvious because the primary reference of Audousset et al. (US' 078) clearly suggests that other customarily used couplers may be included in the dyeing composition (see col. 5, lines 27-29). The secondary reference of Rose et al. (US' 699) clearly teaches that 3-morpholinophenol is among the suitable coupling compounds to be used in the dyeing composition (see col. 9, lines 42-68), and, thus, a person of the ordinary skill in the art would be motivated to incorporate 3-morpholinophenol as a customarily used coupler in the dyeing of Audousset et al. (US' 078) and would expect such a composition to have similar properties to those claimed in the absence of contrary.

Response to Applicant's Arguments

3 Applicant's arguments filed 1/4/2005 have been fully considered but they are not persuasive.

With respect to the rejection based upon Audousset et al. (US' 087) in view of Rose et al. (US' 699), Applicant argues that the morpholinophenol compound is not claimed in the present invention. Further, the applicant argues that none of the examples of the Audousset's reference teaches or suggests the specific claimed combination and the skilled artisan would simply not

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look to this reference for a specific combination of these types of components chosen from among the many listed coupling/developing agents.

The examiner respectfully, disagrees with the above arguments because claim 1 b) recites the compound of 3-morpholinophenol as one of the claimed species (see claim 1b), line 2).

Therefore, the 3-morpholinophenol compound is claimed in the present invention.

With respect to the argument that none of the examples of the Audousset's reference teaches or suggests the specific claimed combination and the skilled artisan would simply not look to this reference for a specific combination of these types of components chosen from among the many listed coupling/developing agents.

The examiner's position is that the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. "*In re Heck*, 699 F.2d 1331, 1332-33 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Iemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). Further, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed.Cir.), cert. denied, 493 U.S. 975 (1989). Therefore, there is a sufficient motivation to one having ordinary skill in the art to formulate a dyeing composition comprising the claimed components based on the general teaching of the references.

Furthermore, the open language of the claim "comprising" allowed a person of ordinary skill in the art to add more dyeing ingredients includes benzimidazole compound in the dyeing composition in the absence of contrary.

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The examiner advises the applicant to provide a data or showing to demonstrate that the claimed composition provides unexpected and unobvious results over the composition of the closest prior art.


Conclusion

The references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
Patent Examiner
Art Unit 1751

January 19, 2005